

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10013329-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Tami L. Guy et al.

Confirmation No.: 3798

Application No.: 09/965,405

Examiner: Laneau, Ronald

Filing Date: September 26, 2001

Group Art Unit: 3714

Title: METHOD OF DISTRIBUTING

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on June 23, 2008.

The fee for filing this Appeal Brief is \$510.00 (37 CFR 41.20).
 No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month \$120 2nd Month \$460 3rd Month \$1050 4th Month \$1640

The extension fee has already been filed in this application.
 (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 510. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

Tami L. Guy et al.

By /Michael A. Goodwin/

Michael A. Goodwin

Attorney/Agent for Applicant(s)

Reg No. : 32, 697

Date : August 24, 2008

Telephone : (303) 298-9888

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT
APPEALS AND INTERFERENCES

In Re Application of:)
)
Tami L. Guy;)
Jeffrey L. Briggs and)
Anne L. Mason)
) Group Art Unit: 3714
)
Serial No. 09/965,405)
) Examiner: Ronald Laneau
)
Filed: September 26, 2001)
)
For: METHOD OF) Atty Dkt. 10013329-1
)
)
DISTRIBUTING)

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted in response to the final rejection of the claims mailed March 24, 2008. A Notice of Appeal was filed on June 23, 2008.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

This brief contains items under the following headings as required by 37 CFR §41.37 and MPEP §1206:

- (1) Real Party In Interest
- (2) Related Appeals, Interferences and Judicial Proceedings
- (3) Status of Claims
- (4) Status of Amendments
- (5) Summary of Claimed Subject Matter
- (6) Grounds of Rejection to be Reviewed on Appeal
- (7) Argument
- (8) Claims Appendix
- (9) Evidence Appendix
- (10) Related Proceedings Appendix

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(1) REAL PARTY IN INTEREST

The real party in interest in the above-referenced patent application is Hewlett-Packard Development Company, LP, having a principal place of business at 20555 S.H. 249, Houston, TX 77070, U.S.A.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences currently known to appellants, appellants' legal representatives or the assignee, which will directly affect, or be directly affected by, or have a bearing on, the Board's decision.

(3) STATUS OF CLAIMS

Claims 1-23 were originally filed with the application. Claims 14, 16 and 20-23 were subsequently canceled during prosecution. Claims 1-13, 15 and 17-19 are currently pending in the application. Claims 1-13, 15, 17 and 18 stand rejected in the final Office action mailed March 24, 2008. Claim 19 is allowed and, thus, does not form a part of this appeal. The rejection of claims 1-13, 15, 17 and 18 is appealed. A copy of the appealed claims appears in appendix (8) to this brief.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(4) STATUS OF AMENDMENTS

No amendments were filed or entered subsequently to the final Office action mailed March 24, 2008.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

In general terms, methods of doing business are disclosed and claimed. Appellants' invention as claimed is summarized and explained below with reference characters, specification page numbers and drawing figure numbers indicating where the claim finds support in the specification and drawings.

1. A method for a first organization (O1) to do business comprising:

entering into a contractual relationship with a second organization (O2); [Fig. 3; page 15, lines 22-25]

authorizing said second organization (O2) to take an order from a customer, said order comprising at least one of: [Figs. 5-6; page 17, line 14 - page 20, line 25]

products not produced by said first organization (O1), and services not provided by said first organization (O1); [Figs. 7-8; page 20, line 26 - page 25, line 19]

receiving payment directly from said customer as a payment for said order taken by said second organization (O2); [Fig. 9; page 25, line 21 - page 27, line 24]

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring an organization other than said first organization (O1) to ship products not produced by said first organization (O1) to said customer; [Fig. 7; page 21, line 2 - page 23, line 25]

requiring an organization other than said first organization (O1) to provide services to said customer. [Fig. 8; page 23, line 27 - page 25, line 19]

2. The method of claim 1 and further comprising:

requiring said second organization (O2) to provide a second organization (O2) service to a customer. [Fig. 8; page 23, line 27 - page 25, line 19]

3. The method of claim 1 and further comprising:

requiring a third organization (O3) to provide a third organization (O3) service to said customer. [Fig. 8; page 23, line 27 - page 25, line 19]

4. The method of claim 1 and further comprising:

requiring a third organization (O3) to ship a third organization (O3) product to said customer. [Fig. 7; page 21, line 2 - page 23, line 25]

5. The method of claim 4 wherein said requiring a third organization (O3) to ship comprises requiring said third

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

organization (O3) to ship said third organization (O3) product from a facility not controlled by said first organization (O1). [Fig. 7; page 21, line 2 - page 23, line 25]

6. The method of claim 4 and further comprising:
verifying that said third organization (O3) product was received by said customer. [Fig. 7; page 21, line 2 - page 23, line 25]

7. The method of claim 3 and further comprising:
verifying that said third organization (O3) service was performed by said third organization (O3). [Fig. 8; page 23, line 27 - page 25, line 19]

8. The method of claim 1 and further comprising:
tracking receipt of said payment by computer.

9. The method of claim 1 and further comprising:
paying said second organization (O2) a predetermined amount based on said order. [Fig. 12; page 33, line 9 - page 34, line 7]

10. The method of claim 9 and further comprising:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

tracking said paying said second organization (O2) by computer.

11. The method of claim 4 and further comprising:
paying said third organization (O3) for said third organization (O3) product. [Fig. 11; page 32, lines 13-25]

12. The method of claim 11 and further comprising:
tracking said paying said third organization (O3) by computer.

13. A method for a first organization (O1) to do business comprising:

requiring a second organization (O2) to take an order for sales items on behalf of the first organization (O1); [Figs. 5-6; page 17, line 14 - page 20, line 25]

in response to a determination that the order includes a product distributed by a third organization (O3) sending an order for that product to the third organization (O3); [Fig. 7; page 21, line 2 - page 23, line 25]

requiring the third organization (O3) to ship the product directly to a customer's address; [Fig. 7; page 21, line 2 - page 23, line 25]

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring the third organization (O3) to notify the second organization (O2) when the product has been shipped; [Fig. 7; page 21, line 2 - page 23, line 25]

wherein the product shipped by the third organization (O3) is less than all items distributed by the third organization (O3) that were on the order; [Fig. 7; page 21, line 1 - page 23, line 25] and

requiring the third organization (O3) to notify the second organization (O2) when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days. [Fig. 7; page 21, line 1 - page 23, line 25].

15. The method of claim 13 further comprising:
invoicing the customer after the third organization (O3) notifies the second organization (O2) that the product has been shipped. [Fig. 9; page 25, line 20 - page 27, line 24]

17. The method of claim 13 further comprising:
requiring the second organization (O2) to notify the first organization (O1) when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days. [Fig. 7; page 21, line 1 - page 23, line 25]

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

18. A method for a first organization (O1) to do business comprising:

requiring a second organization (O2) to take an order for sales items on behalf of the first organization (O1); [Fig. 7; page 21, line 2 - page 23, line 25]

in response to a determination that the order includes a product distributed by a third organization (O3) sending an order for that product to the third organization (O3); [Fig. 7; page 21, line 2 - page 23, line 25]

requiring the third organization (O3) to notify the first organization (O1) when the order exceeds a predetermined credit limit of the second organization (O2). [Fig. 5; page 17, line 13 - page 19, line 1]

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Claims 1-6 and 8-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Curie et al. (U.S. Patent No. 6,871,232).
- B. Claim 7 stands under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Curie et al. (U.S. Patent No. 6,871,232) and further

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

in view of Hogan (U.S. Patent Application Publication No. 2001/0002464 A1).

- C. Claims 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Carpenter et al. (U.S. Patent No. 6,868,401).
- D. Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Work et al. (Published U.S. Patent Application No. 2002/0007302).
- E. Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Bremers (U.S. Patent No. 6,901,380). Arguments begin on page 52.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(7) ARGUMENT

Argument re Issue A

Claims 1-6 and 8-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Curie et al. (U.S. Patent No. 6,871,232). Appellants respectfully assert, for at least the reasons advanced below, that this rejection is improper and that the Examiner should be reversed.

Appellants' claim 1 recites the following:

A method for a first organization to do business comprising:
 entering into a contractual relationship with a second organization;
 authorizing said second organization to take an order from a customer, said order comprising at least one of:
 products not produced by said first organization,
 and services not provided by said first organization;
 receiving payment directly from said customer as a payment for said order taken by said second organization;

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring an organization other than said first organization to ship products not produced by said first organization to said customer;

requiring an organization other than said first organization to provide services to said customer.

Appellants' claim 1 recites, for example, a first organization:

entering into a contractual relationship with a second organization;

authorizing said second organization to take an order from a customer ...

receiving payment directly from said customer as a payment for said order taken by said second organization;

Thus, in appellants' claim 1, a first organization enters into a contractual relationship with a second organization, authorizes the second organization to take an order from a customer and receives payment directly from the customer for the order.

The Examiner states the following on page 2 of the final Office action:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

As to claim 1, Sharp discloses a method for a first organization to do business comprising: authorizing said second organization to take an order from a customer (i.e. supplier) (col. 3, lines 20-25); receiving payment directly from said customer as a payment for said order taken by said second organization (col. 4, lines 2-4);

From the above, the Examiner's position is not entirely clear. It is not clear, for example, which of the entities recited by appellants (i.e., the second organization or the customer) is believed to be met by the Sharp et al. "supplier". As explained in further detail below, however, appellants respectfully assert, that, under either interpretation, the Sharp et al. and Curie et al. references fail to disclose or suggest all of the limitations of claim 1.

The Examiner points to col. 3, lines 20-25 and col. 4, lines 2-4 of Sharp et al. in support of the current rejection. The portions of Sharp et al. referenced by the Examiner are reproduced, in broader context, as follows:

Using computer system 100, a customer using client computer 120 can access an e-commerce website hosted on server computer 110 via computer network 150. The e-commerce website allows the customer to select among a large assortment of products from different manufacturers. In some embodiments, the products sold through the e-commerce website relate to a particular market segment,

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

such as extreme sports equipment and apparel. The e-commerce website allows the customer to place multiple orders for multiple products and/or services in a single session. The order includes both information about the product, such as manufacturer, model number and selected options, as well as information about the customer, such as **name, address and credit information. Once the customer has entered and confirmed the order, a computer program executed on server computer 110 processes the order. The computer program allocates the order to a supplier of the product according to a distribution channel conflict resolution scheme specified by the manufacturer of the product.**

(Sharp et al., col. 3, lines 7-24) (the text from col. 3, lines 20-25 appears in bold))

FIG. 3 is a flow diagram of the operation 300 of computer system 100 of FIG. 1. First, a customer browses or logs-in to an e-commerce website hosted by server computer 110 via client computer 120 and computer network 150 in stage 303. The customer then enters the order information in stage 306. The customer then confirms the order information causing the computer program executed by server computer 110 to compute tax and shipping costs and add to the order **information, all in stage 309. The credit card or other payment information submitted by the customer is verified and processed in stage 312. If verification for the payment information is not obtained, the customer is asked to re-enter the information or provide alternative payment information. Once the payment information has been successfully verified, the order is finalized and entered into database 230 in stage 315. Order confirmation information, including an order number and a**

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

link to an order/shipping information web page, is e-mailed to the customer in stage 318.

(Sharp et al., col. 3, line 61 - col. 4, line 11 (the text from col. 4, lines 2-4 appears in bold))

Thus, in the first Sharp et al. excerpt reproduced above, the customer places an order for one or more products with an “e-commerce website” hosted on a server computer 110. The server computer 110 then allocates the order to one or more suppliers of the product(s). In the second excerpt, Sharp et al. discusses how the server computer 110 verifies and processes the customer’s credit card or other payment information.

Sharp et al. further discusses the payment process as follows:

Once the product has been timely shipped by the supplier, database 230 is updated to reflect the shipment information in stage 372. A shipping company then picks the product from the supplier and delivers it to the customer in stage 375. An e-mail confirmation message is sent to the customer in stage 381. **The customer credit card, or other payment instrument, is debited with the cost of the product plus any applicable taxes and shipping and handling charges** in stage 384. **Funds are transferred to the supplier and the shipping company to cover the cost of the product and the shipping charges** in stage 387. Finally, in stage 390, the customer verifies order and shipping status by accessing the e-commerce website

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

on-line using the order and link information supplied in stage 318.

(Sharp et al., col. 5, lines 5-18, bold emphasis added)

Thus, in Sharp et al., the server computer 110 first collects the total cost of the order from the customer, including, for example, the product cost, the shipping cost and any taxes. The server computer 110 then transfers the appropriate amounts to the product supplier and the shipping company. Thus, in Sharp et al., *the server computer 110 serves as an intermediary for payment; payment is not sent directly from the customer to the supplier.*

In Sharp et al., the e-commerce website (operating on the server computer 110) takes the order from the customer and processes the customer's payment information. In appellants' claim 1, on the other hand, the second organization takes the order; however, *the first organization receives payment directly from the customer.* Thus, Sharp et al. fails to disclose or suggest all of the limitations of appellants' claim 1. Curie et al. does nothing to remedy the inadequacy of Sharp et al.

For at least the reasons advanced above, appellants respectfully assert that the limitations of claim 1 are not met by the proposed combination of the Sharp et al. and Curie et al.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

references and that, accordingly, a *prima facie* case of obviousness has not been established.

Appellants further respectfully assert that a *prima facie* case of obviousness has not been established because there is improper motivation to combine the references as proposed by the Examiner.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner's explanation regarding obviousness set forth in the final Office action is reproduced as follows:

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Curie within Sharp *for the motivation of offering additional services not offered by direct sellers thereby providing an incentive and increased choices for customers.*

(final Office action, page 3, emphasis added)

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

The language italicized above represents the Examiner's only explanation regarding a teaching or suggestion to combine. This language, however, represents, at best, a *broad conclusory statement* made by the Examiner. The Examiner has not referred to any prior art or authority in support of the position that a motivation or suggestion to combine exists but, instead, apparently expects the unsupported conclusory statement reproduced above to suffice. Such an unsupported statement, however, cannot constitute the evidence required to establish existence of a motivation or suggestion to combine:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... Broad conclusory statements standing alone are not "evidence".

In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999))

Accordingly, the Examiner's statement does not constitute a showing of a teaching or suggestion to combine since the Examiner provides no evidence of the requisite motivation to combine but, instead, attempts to rely on an unsupported statement of personal opinion. Such personal opinion does not represent an adequate substitute for evidence.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

It is noted that the requirements for obviousness are discussed in the Supreme Court's relatively recent decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007). The U.S. Patent and Trademark Office comments on the KSR decision, for example, as follows:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting In re Kahn 41 stated that “ '[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.' ”

57526 Federal Register, Vol. 72, No. 195 (October 10, 2007) “Notices Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*”, at pages 57528-57529

Thus, the U.S. Patent and Trademark Office's own Examination Guidelines dictate that the framing of a proper rejection under 35 U.S.C. §103(a) requires more than mere conclusory statements.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

Accordingly, appellants respectfully assert that the Examiner has not established a *prima facie* case of unpatentability and that, therefore, claim 1 is in condition for allowance. Claims 2-6 and 8-12 are allowable at least as ultimately depending from allowable base claim 1. For purposes of this issue on appeal, claims 2-6 and 8-12 stand or fall with claim 1.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

Argument re Issue B

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) and Curie et al. (U.S. 6,871,232 B2), as applied to claim 1 and further in view of Hogan (U.S. Published Application No. 2001/0002464). Appellants respectfully assert, for at least the reasons advanced below, that this rejection is improper and that the Examiner should be reversed.

Claim 7 is allowable at least as ultimately depending from allowable base claim 1. Claim 7 is allowable on further independent grounds, for the reasons advanced below.

Appellants' claim 7 recites the following:

The method of claim 3 and further comprising:
verifying that said third organization service was
performed by said third organization.

Appellants respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 7 because there is no suggestion or motivation to combine the teachings of the Sharp et al., Curie et al. and Hogan references as proposed by the Examiner. The law requiring that the Examiner

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

demonstrate a suggestion or motivation to combine is discussed in more detail above with respect to the rejection of claim 1. To avoid repetition by reproducing that discussion here, appellants instead hereby incorporate the discussion by reference into the arguments advanced below regarding the rejection of claim 7.

The Examiner states the following on page 5 of the final Office action regarding the combination of references proposed to support the rejection of claim 7:

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Hogan into the combined systems of Sharp and Curie *for the motivation of automating equipment servicing and task management to allow access to maintenance reports (paragraph 12)*

(emphasis added)

The language italicized above represents the Examiner's only explanation regarding a suggestion or motivation to combine the Sharp et al., Curie et al. and Hogan reference teachings. As discussed above with respect to the rejection of claim 1, however, this type of unsupported conclusory statement is insufficient to establish the legally-requisite motivation or suggestion to combine reference teachings.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

In view of the arguments advanced above, appellants respectfully assert that the Examiner has not established a *prima facie* case of unpatentability and that, therefore, claim 7 is in condition for allowance.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

Argument re Issue C

Claims 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Carpenter et al. (U.S. 6,868,401). Appellants respectfully assert, for at least the reasons advanced below, that this rejection is improper and that the Examiner should be reversed.

Appellants' independent claim 13 recites the following:

A method for a first organization to do business comprising:
 requiring a second organization to take an order for sales items on behalf of the first organization;
 in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;
 requiring the third organization to ship the product directly to a customer's address;
 requiring the third organization to notify the second organization when the product has been shipped;
 wherein the product shipped by the third organization is less than all items distributed by the third organization that were on the order; and

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring the third organization to notify the second organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

Appellants respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 13 because there is no suggestion or motivation to combine the teachings of the Sharp et al. and Carpenter et al. references as proposed by the Examiner. The law requiring that the Examiner demonstrate a suggestion or motivation to combine is discussed in more detail above with respect to the rejection of claim 1. To avoid repetition by reproducing that discussion here, appellants instead hereby incorporate the discussion by reference into the arguments advanced below regarding the rejection of claim 13.

The Examiner states the following on page 6 of the final Office action regarding the combination of references proposed to support the rejection of claim 13:

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Carpenter within Sharp *for the motivation of processing transactions through a computer network and tracks transaction through to completion (col. 2, lines 8-15)*

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(emphasis added)

The language italicized above represents the Examiner's only explanation regarding a suggestion or motivation to combine the Sharp et al. and Carpenter et al. reference teachings. As discussed above with respect to the rejection of claim 1, however, this type of unsupported statement is insufficient to establish the legally-requisite motivation or suggestion to combine reference teachings.

In view of the arguments advanced above, appellants respectfully assert that the Examiner has not established a *prima facie* case of unpatentability and that, therefore, claim 13 is in condition for allowance. Claim 15 is allowable at least as ultimately depending from allowable base claim 13.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

Argument re Issue D

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Work et al. (Published U.S. Patent Application No. 2002/0007302). Appellants respectfully assert, for at least the reasons advanced below, that this rejection is improper and that the Examiner should be reversed.

At the outset, appellants point out that claim 17 depends from independent claim 13 and the Examiner has rejected claim 13 over Sharp et al. in view of Carpenter et al. (see appellants' arguments re claims 13 and 15). Thus, it would appear that the basis for the rejection of claim 17 should include the Carpenter et al. reference.

In any event, appellants respectfully assert that the present rejection of claim 17 is improper because there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner (whether that combination is Sharp et al. in view of Carpenter et al. or Sharp et al. and Work et al. in view of Carpenter et al.).

Appellants' claim 17 recites the following:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

The method of claim 13 further comprising:
requiring the second organization to notify the first organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

The law requiring that the Examiner demonstrate a suggestion or motivation to combine is discussed in more detail above with respect to the rejection of claim 1. To avoid repetition by reproducing that discussion here, appellants instead hereby incorporate the discussion by reference into the arguments advanced below regarding the rejection of claim 17.

The Examiner states the following on page 7 of the final Office action regarding the combination of references proposed to support the rejection of claim 17:

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Work within Sharp *for the motivation of tracking vendor compliance with guidelines imposed on distributors, senders, shippers and the like in a supply chain (paragraph 8)*

(emphasis added)

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

The language italicized above represents the Examiner's only explanation regarding a suggestion or motivation to combine the reference teachings. As discussed above with respect to the rejection of claim 1, however, this type of unsupported statement is insufficient to establish the legally-requisite motivation or suggestion to combine reference teachings.

In view of the arguments advanced above, appellants respectfully assert that the Examiner has not established a *prima facie* case of unpatentability and that, therefore, claim 17 is in condition for allowance.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

Argument re Issue E

Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sharp et al. (U.S. Patent No. 6,263,317) in view of Bremers (U.S. Patent No. 6,901,380). Appellants respectfully assert, for at least the reasons advanced below, that this rejection is improper and that the Examiner should be reversed.

Appellants' claim 18 recites the following:

A method for a first organization to do business comprising:
 requiring a second organization to take an order for sales items on behalf of the first organization;
 in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;
requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization.

(emphasis added)

On page 8 of the final Office action, the Examiner admits that Sharp et al. fails to disclose the limitation highlighted above, but

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

takes the position that this is taught by Bremers. The Examiner points to col. 9, lines 10-20 of Bremers in support of this position. This portion of the Bremers reference is reproduced as follows:

In an embodiment of the present invention, incoming orders may be processed by the business application 200 to detect and potentially resolve variances before being authorized and communicated to a vendor. Variances can be detected based on expected value (e.g., variances may include an order having an amount greater than a given credit limit or a lapsed shipping date). A notice of a variance may be presented to a business user for resolution (e.g., authorizing a higher credit limit or modifying the shipping date).

In this excerpt, the application 200 *detects and resolves* variances (e.g., exceeding a credit limit) *before* the order is communicated to the vendor. Thus, Bremers does not disclose that the vendor is notified when an order exceeds a credit limit. This is contrary to appellants' claim 18, which requires that the third organization notify the first organization when the order exceeds a predetermined credit limit of the second organization.

For the reasons advanced above appellants respectfully assert that all of the limitations of claim 18 are not met by the proposed combination of the Sharp et al. and Bremers references

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

and that, accordingly, a *prima facie* case of obviousness has not been established.

Appellants further respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 18 because there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. The law requiring that the Examiner demonstrate a suggestion or motivation to combine is discussed in more detail above with respect to the rejection of claim 1. To avoid repetition by reproducing that discussion here, appellants instead hereby incorporate the discussion by reference into the arguments advanced below regarding the rejection of claim 18.

The Examiner states the following on page 8 of the final Office action regarding the combination of references proposed to support the rejection of claim 18:

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed Bremers within Sharp *for the motivation of a system that provides feedback representing purchase order or customer information changes (col. 2, lines 35-45)*.

(emphasis added)

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

The language italicized above represents the Examiner's only explanation regarding a suggestion or motivation to combine the Sharp et al. and Bremers reference teachings. As discussed above with respect to the rejection of claim 1, however, this type of unsupported statement is insufficient to establish the legally-requisite motivation or suggestion to combine reference teachings.

In view of the arguments advanced above, appellants respectfully assert that the Examiner has not established a *prima facie* case of unpatentability and that, therefore, claim 18 is in condition for allowance.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

For the reasons set forth above, appellants respectfully assert that all of the claims are allowable and that, accordingly, all of the rejections should be reversed.

Respectfully submitted,
KLAAS, LAW, O'MEARA & MALKIN, P.C.

By: /Michael A. Goodwin/
Michael A. Goodwin
Registration No. 32,697
1999 Broadway, STE 2225
Denver, CO 80202
(303) 298-9888

Date: August 24, 2008

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(8) CLAIMS APPENDIX

1. A method for a first organization to do business comprising:
 - entering into a contractual relationship with a second organization;
 - authorizing said second organization to take an order from a customer, said order comprising at least one of:
 - products not produced by said first organization, and services not provided by said first organization;
 - receiving payment directly from said customer as a payment for said order taken by said second organization;
 - requiring an organization other than said first organization to ship products not produced by said first organization to said customer;
 - requiring an organization other than said first organization to provide services to said customer.
2. The method of claim 1 and further comprising:
 - requiring said second organization to provide a second organization service to a customer.
3. The method of claim 1 and further comprising:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring a third organization to provide a third organization service to said customer.

4. The method of claim 1 and further comprising:
requiring a third organization to ship a third organization product to said customer.
5. The method of claim 4 wherein said requiring a third organization to ship comprises requiring said third organization to ship said third organization product from a facility not controlled by said first organization.
6. The method of claim 4 and further comprising:
verifying that said third organization product was received by said customer.
7. The method of claim 3 and further comprising:
verifying that said third organization service was performed by said third organization.
8. The method of claim 1 and further comprising:
tracking receipt of said payment by computer.
9. The method of claim 1 and further comprising:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

paying said second organization a predetermined amount based on said order.

10. The method of claim 9 and further comprising:
tracking said paying said second organization by computer.

11. The method of claim 4 and further comprising:
paying said third organization for said third organization product.

12. The method of claim 11 and further comprising:
tracking said paying said third organization by computer.

13. A method for a first organization to do business comprising:
requiring a second organization to take an order for sales items on behalf of the first organization;
in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;
requiring the third organization to ship the product directly to a customer's address;
requiring the third organization to notify the second organization when the product has been shipped;

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

wherein the product shipped by the third organization is less than all items distributed by the third organization that were on the order; and

requiring the third organization to notify the second organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

14. (canceled)

15. The method of claim 13 further comprising:
invoicing the customer after the third organization notifies the second organization that the product has been shipped.

16. (canceled)

17. The method of claim 13 further comprising:
requiring the second organization to notify the first organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a predetermined number of days.

18. A method for a first organization to do business comprising:

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

requiring a second organization to take an order for sales items on behalf of the first organization;

in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;

requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization.

Claim 19 is allowed.

Claims 20-23 (canceled)

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(9) EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131 or 1.132 or entered by or relied upon by the examiner is being submitted.

Serial No. 09/965,405
Tami L. Guy, et al.
Atty Dkt: 10013329-1
Appeal Brief

(10) RELATED PROCEEDINGS AND INTERFERENCES

APPENDIX

No related proceedings are referenced in (2) above.
Accordingly, no copies of decisions in related proceedings are provided.